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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/818,771	03/14/1997	MOJTABA MIRASHRAFI	002784.P001	9980

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EXAMINER

NGUYEN, STEVEN H D

ART UNIT

PAPER NUMBER

2665

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39

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/818,771

Applicant(s)

MIRASHRAFI ET AL.

Examiner

Steven HD Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-9,11,13-19,21-25,29,30 and 33-43 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.

- 6) ☒ Claim(s) 1-4,6-9,11,13-19,21-25,29,30 and 33-43 is/are rejected.

- 7) ☐ Claim(s) _____ is/are objected to.

- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4, 11, 13, 16-19, 21, 24, 29-30, 33-35 and 39-43 are rejected under 35

U.S.C. 102(e) as being anticipated by Radziewicz (USP 5854897).

As claims 1, 33-35 and 39-43, Radziewicz discloses a bridge server, a method comprising receiving by said bridge server from a client system a request for content targeting a network server, and determining by said bridge server, based on said received request and not on the requested content, additional content other than the requested content to be provided to the client system by the network server; and providing by said bridge server said determined additional content or an identifier of said additional content to said client system (See claims 1 or 28 wherein the NPS is a means plus function for performing the claimed invention which is disclosed in the specification such intercepting a request packet from the client to a target and using the IP address, URL to identified the addition content such as telephone number etc from a database of announcement server for transmitting to the client with the requested information).

As claim 2, Radziewicz discloses additional content comprises additional information regarding said network server to said client system (See claims 1 and 28).

As claim 3, Radziewicz discloses said providing comprises providing by said bridge server said additional content to said client system without altering the substance of the requested content to be provided by said network server (See claim 6 or 7).

As claim 4, Radziewicz discloses determining comprises checking by said bridge server whether additional content corresponding to said network server exists (See claims 1 and 28, the NSP checks the announcement server for addition information).

As claim 11, Radziewicz discloses the identifier of the additional content comprises a Uniform Resource Locator (URL) corresponding to the additional content (See claim 23).

As claim 13, Radziewicz discloses marking the received request by the bridge server and returning by the bridge server to the client system, the marked version of the received requested for re-submission by the client system (As claim 12, the announcement window includes a marked version for allowing the client to resubmitted).

As claims 16-18, Radziewicz discloses said providing comprises returning by the bridge server a Hyper Text Markup Language (HTML) page to the client system, wherein the HTML page includes a marked version of the request for resubmission by the client system; said providing comprises returning by said bridge server a Hypertext Markup Language (HTML) page to the client system, wherein the HTML page includes said identifier of the additional content for the client system to retrieve the additional content; providing comprises returning a Hypertext Markup Language (HTML) page to the client system, wherein the HTML page includes the additional content (As claim 12, the announcement window includes a marked version for allowing the client to resubmitted).

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As claim 19, Radziewicz discloses bridge server comprising control logic operative to receive a request for content from a client system targeting a network server, and to check, based on said received request and not on the requested content, whether additional content is to be provided to the client system, in addition to the requested content to be provided to the client system by the network server; and content-adding logic, coupled to the control logic, operative to provide the additional content or an identifier of said additional content to the client system if the additional content is to be provided (See claims 1 or 28 wherein the NPS is a means plus function for performing the claimed invention which is disclosed in the specification such intercepting a request packet from the client to a target and using the IP address, URL to identified the addition content such as telephone number etc from a database of announcement server for transmitting to the client with the requested information).

As claim 21, Radziewicz discloses the identifier comprises a Uniform Resource Locators (See claim 23).

As claims 24 and 29-30, Radziewicz discloses receiving by the bridge server a request for content from a client system targeting a network server; and marking up by the bridge server the received request and returning the marked up request to the client system for re-submission and means for transmitting another request for additional content, upon receipt of an identifier of the additional content from said bridge server provided in response to the first transmission of the request (See claims 1 or 28 wherein the NPS is a means plus function for performing the claimed invention which is disclosed in the specification such intercepting a request packet from the client to a target and using the IP address, URL to identified the addition content in the markup form from a database of announcement server for transmitting to the client for resubmitted).

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3. Claims 24-25 and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Haserodt (USP 6031836).

As claims 24-25 and 29, Haserodt discloses in Fig 2, a client including means for transmitting a request that target the server 105 and means for retransmitting the marked up request after receiving a mark up form which marked up by a bridge server 104; (See col. 3, lines 55 to col. 4, lines 60, the bridge server marked up the requested into a markup form to forward to client).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 6-9, 22 and 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over anticipated by Radziewicz in view Rondeau (USP 5850433).

As claims 6-9, 22 and 36-38, Radziewicz discloses addition information is telephone number for allowing the client to make a phone call later or web page with the hyper links. However, Radziewicz does not disclose said additional content comprises an option for making a telephone call. In the same field of endeavor, Rondeau discloses a system for allowing a client to make a telephone call between a computer and convention telephone without terminating the connection and dialing the telephone number; said option for making a telephone call is an option allowing a user of the client computer system to make the telephone call without having to provide the destination telephone number by the user; said option for making a telephone call is an option allowing a user of the client system to make the telephone call without terminating a current network communication session of the client system; automatically establishing and facilitating a voice call to a PSTN handset in response to a user of the client system selecting the additional content (See Abstract and the database server returned the marked request to client for resubmitting the requested such as making a telephone call).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a method of returning the marked request in the form of embedded a telephone number into a button to allow the user to contact the customer's representative as taught by Rondeau into the Radziewicz' method. The motivation would have been to allow the customer interactive to a customer representative right away, if the customer does not satisfy with a detail description on the web page.

7. Claims 14, 23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over anticipated by Radziewicz and Rondeau in view Gabber (USP 5961593).

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As claims 14, 23, 25, Radziewicz and Rondeau do not disclose the claimed invention. However, in the same field of endeavor, Garber discloses receiving by the bridge server, the marked version of the request re-submitted by the client system; removing by the bridge server, the marking from the re-submitted request; and forwarding the request to the network server (Fig 6).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a method of removing the mark up requests before forwarding the request to target server as taught by Garber's method into the method and apparatus of Rondeau and Radziewicz. The suggestion/motivation would have been to reduce the cost of consumer access fees.

8. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over anticipated by Radziewicz in view Gabber (USP 5961593).

As claims 15, Radziewicz does not disclose the claimed invention. However, Garber discloses the marked version of the request comprises a Uniform Resource Locator (URL) corresponding to the request, appended with additional characters identifying the bridge server as the marking bridge server (Fig 6).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a method of adding a tag to the mark up requests before forwarding to client as taught by Garber's method into the method and apparatus of Radziewicz. The suggestion/motivation would have been to reduce the cost of consumer access fees.

9. Claims 1-4, 11, 17-19, 21 and 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz (USP 5754938) in view Van Hoff (USP 5822539).

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As claim 1-4, 11, 17-19, 21 and 33-34, Herz discloses a bridge server “proxy server, S2” for receiving a request for content of a target server “Server S4” which is not targeting the bridge server; determining by said bridge server based on the received request, additional content other than the requested content to be provided to the client system by the network server (col. 39, lines 64 to col. 4, lines 36 wherein the addition information is belong to the retrieved information of a server 4). Herz does not disclose a step of determining addition content based on the received request from the client. However, Van Hoff discloses a step of determining if any addition contents are associated with the remote information server, then selecting an addition content to relay to the user (Fig 2, Ref 120 for determining if any documents are related to the requested information, if yes, selecting the addition information for merging into the document from the server 104); a step of sending an additional content without altering from requested information (It’s implicitly shown by Van Hoff because Van Hoff does not disclose a step of altering As claim 3); an addition information comprising hyperlink to identify the additional content information; information being mark or tag by hyperlink such as URL to allow the user to retrieve the addition information (See Fig 4; As claim 11, 17-18 and 21).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention was made to apply a step of determining if addition content is required for the requested before receiving the content information from the targeting server as disclosed Van Hoff’s method and system into Herz’s system. The motivation would have been to reduce the delay time and improve the throughput of a server.

10. Claim 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haserodt as applied to claim 29 above, and further in view of Rondeau (USP 5850433).

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As claim 30, Haserolt does not disclose the claimed invention. However, Rondeau disclosed a client system that transmits another request upon receiving an identifier of addition content from a server "Fig 1, Ref 28"; (a client clicks on the telephone icon to talk to the telephone 22 for addition content).

Since, Rondeau suggests a method of embedding the telephone number into a mark up page. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a telephone number into a web page as addition content for allowing a user to contact with an agent for obtaining more information as disclosed by Rondeau into Harserolt's communication system. The motivation would have been to prevent the human error.

11. Claims 6-9, 22 and 36-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz and Van Hoff as applied to claims 1, 19 and 33 above, and further in view of Rondeau (USP 5850433).

As claims 6-9, 22 and 36-43, Herz and Van Hoff fail to disclose the claim invention. Rondeau discloses the additional content information comprising an option to make a phone call by allowing a user to click on the icon (Fig 2, Ref 54) to make a phone call via the network to a PSTN handset (Fig 1, Ref 22) and the addition content such as telephone number must be marked by the access server for returning to the user in a form such as icon or button.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a database server which includes a telephone icon as disclosed by Rondeau into a server's Herz and Van Hoff. The motivation would have been to reduce the amount of time required to place a telephone to one of provider.

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12. Claims 13-14, 16, 23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz and Van Hoff as applied to claims 1 and 19 above, and further in view of Haserodt (USP 6031836).

As claims 13-14, 16, 23 and 25, Herz and Van Hoff do not disclose the claimed invention. However, in the same field of endeavor, Haserodt a bridge server (Fig 1, Ref 104) for receiving a request for content which targets a network server (Fig 1, 105); the bridge server 104 marks up the request and returns to the user for resubmitting (Fig 1, Ref 1, Fig 2 discloses a server 104 for receiving a request for content of a network server 105 from user 113; the server 104 generates a mark up request form for transmitting to the user 113; allowing the user 113 to resubmit the request the marked up content to server 104) for establishing a telephone call; See col. 3, lines 55 to col. 4, lines 60.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a step of marking up the request for transmitting to the client and allowing the client to resubmit the request as disclosed by Haserodt into Herz and Van Hoff's communication system. The motivation would have been to allow a client to contact with an agent in real time.

13. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over anticipated by Herz and Van Hoff in view Gabber (USP 5961593).

As claims 15, Herz and Van Hoff do not disclose the claimed invention. However, Garber discloses the marked version of the request comprises a Uniform Resource Locator (URL) corresponding to the request, appended with additional characters identifying the bridge server as the marking bridge server (Fig 6).

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Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a method of adding a tag to the mark up requests before forwarding to client as taught by Garber's method into the method and apparatus of Herz and Van Hoff. The suggestion/motivation would have been to reduce the cost of consumer access fees.

14. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over anticipated by Herz and Van Hoff in view Radziewicz (USP 5854897).

Herz and Van Hoff do not disclose the claimed invention. However, Radziewicz discloses the addition content determined based on the address of the server (col. 10, lines 9-15).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a method of determined the addition content based on the address of the server as disclosed by Radziewicz into Herz and Van Hoff. The motivation would have been to reduce the cost of consumer access fees.

Response to Arguments

15. Applicant's arguments filed 03/28/03 have been fully considered but they are not persuasive.

In response pages 10-12, the applicant states that Haserodt does not disclose a marked up from to the client for resubmitted. In reply, Haserodt discloses a client generating a request for establishing a connection with a telephone server via a web server. The web server transmitted a form which has the marked up request for the client enter the information in order to resubmitted to the web server and the web server removes the markup and forwarding the data to the

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telephone server as claim 13, 23-25 and 29. So the teaching of Haserodt performs the claimed invention.

In response to pages 13-15, the applicant states that Hert and Van Hoff do not disclose a step of determining based on the request. In reply, Hert discloses an advertising material that is related to the user's request transmits to the client by proxy server. So proxy server retrieves the advertising based on the user's request not on received requested at the client or proxy server (See col. 39, lines 64-67). So the teaching of Haserodt performs the claimed invention.

In response to the applicant states that Radziewicz is not a prior art according to the affidavit filed on 3/12/2001 or 11/14/00. In reply, the affidavit filed on 3/12/2001 or 11/14/00 under 37 CFR 1.131 is *ineffective* to overcome to Radziewicz reference because the Radziewicz is a U.S. patent that claims the rejected invention. In this case, Radziewicz claim a means plus function (NSP program that intercepts the request and using the IP of user and URL of target server for retrieving the addition content) of with includes the function in the specification. An affidavit or declaration is *inappropriate* under 37 CFR 1.131(a) when the patent is claiming the same patentable invention, see MPEP § 2306. ***The patent can only be overcome by establishing priority of invention through interference proceedings.*** See MPEP Chapter 2300 for information on initiating interference proceedings and Chapter 700 section 715.04-715-06.

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven HD Nguyen whose telephone number is (703) 308-8848. The examiner can normally be reached on 8-5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy D Vu can be reached on (703) 308-6602. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

A handwritten signature in black ink, appearing to read 'Steven HD Nguyen', with a large, sweeping flourish extending from the end of the signature.

Steven HD Nguyen
Primary Examiner
Art Unit 2665
June 1, 2003